

of an issue of premature finality of final rejection (MPEP § 706.07(c) and (d)) must be adjudicated before a meaningful appeal brief on the merits can be prepared or filed.

Kindly charge the petition fee of \$ 200.00 to Deposit Account No. 23-2405, Order No. 114596-03-4000.

**A. Sufficient Cause Exists for an Extension of Time**

An Office Action was mailed on 10/25/2004. That Office Action was designated “final.” In post-final papers, the examiner himself conceded that his Office Action was neither “complete” nor “clear,” *contra* 37 C.F.R. §§ 1.104(b), 1.104(c)(2), 1.113(a). *See, e.g.*, Advisory Action of 2/5/2005 ¶ 3 (Examiner states that an entire paragraph of his final action was mis-copied from elsewhere, and is now replace with a paragraph that provides the first disclosure of the Examiner's view, based on a new portion of a reference).

A Petition to Withdraw Finality was filed on 4/25/2005. A paper was sent by SPPrE Brian Johnson on 9/9/2005, however, that paper was beyond Mr. Johnson's authority. That paper also failed to adjudicate a number of issues that were squarely presented, and stated a number of propositions of law that do not reflect – and indeed are directly contrary to – all authority that has force of law.

In a telephone interview of 10/30/2005, T.C. Director Harvey agreed that the 9/9/2005 paper was issued without agency authority, and would have to be reissued. A number of oversights in the 9/9/2005 paper were also discussed. *See* Summary of Interview (10/30/2005), and the accompanying email, and the Supplementary Petition of 10/31/2005 (see especially FAX cover sheet , showing that this Supplement was FAXed directly to SPPrE Johnson on 10/31/2005). T.C. Director Harvey stated that he would not apply the law, and that court and agency precedent would not be “useful” in his decision.

An essentially identical paper was reissued by the PTO on 11/8/2005. The 11/8/2005 paper fails to “answer all material traversed” in the supplementary petition of 10/31/2005. *Contra* MPEP § 707.07(f); 5 U.S.C. § 555(a) (“With due regard for the ... necessity of the parties ... and within a reasonable time, each agency shall proceed to conclude a matter presented to it.”); *Motor Vehicle Manufacturers' Assn. of the United States Inc. v. State Farm*

*Mutual Automobile Insurance Co.*, 463 U.S. 29, 48 (1983) (every written decision of every federal agency must “cogently explain why [the agency] has exercised its discretion in a given manner.”). All written agency decisions “must examine the relevant data and articulate a satisfactory explanation for its action including a rational connection between the facts found and the choice made.” *Id.* at 43. No agency decision may “entirely fail[ ] to consider an important aspect of the problem, [or] offer[ ] an explanation for its decision that runs counter to the evidence before the agency.” *Id.*

Thus, we find ourselves at a juncture where, at T.C. Director Harvey’s own admission, no decision has been rendered under the law. Even the incomplete paper of 11/8/2005 was issued a full seven months after the Petition, essentially exhausting all available time for reconsideration of these issues. At the very least, the Supplementary Petition of 10/31/2005 and the paper of 11/8/2005 “crossed in the mail,” and a decision should be rendered on the issues raised in the Supplementary Petition.

The time to seek further review within the PTO under ordinary rules has expired, at no fault of this applicant, and only an incomplete and legally inadequate decision has been rendered. An extension of time is warranted.

**B. A Reasonable Time for Extension, and Requests for Related Relief**

Action by the Office on the merits should be suspended until all issues raised in the Petition to Withdraw Finality are fully and fairly adjudicated. *In re Kumar*, 418 F.3d 1361, 1367, 76 USPQ2d 1048, 1052 (Fed. Cir. 2005) (“In accordance with the Administrative Procedure Act, the agency must assure that an applicant’s petition is fully and fairly treated at the administrative level...”).

Applicant suggests that the Petition to Withdraw Finality of April 2005 (as supplemented 6/14/2005 and 10/31/2005) should be remanded to the T.C. Director for full and fair decision. Applicant suggests that the T.C. may find it helpful to consult with the Office of General Counsel or the Office of Petitions on legal issues. The email of 11/1/2005 and Supplemental Petition of 10/31/2005 provide useful “checklists” to ensure that all issues are addressed fully and fairly.

In the event that the Petition is denied at the T.C. Director level, Applicant should have the opportunity to seek further review from the Office of Petitions within one month.

In the event that the Petition to Withdraw Finality is granted at either level, the finality of the Office Action of 10/25/2005 is withdrawn. All time deadlines running from 10/25/2004 were tolled by the Response filed 1/25/2005. The Amendment filed 4/25/2005 is then entered by operation of law as a supplementary amendment, and the arguments provided in the "Response to Office Action, or in the alternative, Appeal Brief," may be considered in preparation of the next Office Action. All fees for extension of time were paid "in excess of that required," and may be refunded pursuant to 37 C.F.R. § 1.26(a).

In the event that the Petition is finally denied, then Applicant's appeal brief or RCE should be due one month from the date that all petition process within the PTO is exhausted.

## **II. Conditional Petition Pursuant to 37 C.F.R. § 1.136(a)**

In the alternative, or supplementary to any extension granted under 37 C.F.R. § 1.136(b), Applicant petitions for an extension of time to file an Appeal Brief. A five-month extension extends time to November 28, 2005 (seven months from the "date of receipt of the notice of appeal," MPEP § 1205.01).

Only in the event that such petition must be granted to maintain pendency, kindly charge the petition fee of \$2,160.00 to Deposit Account No. 23-2405, Order No. 114596-03-4000.

Respectfully submitted,

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